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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/838,045

04/18/2001

Donald J. Mischo

MISCHO-1

2957

20606

7590

08/09/2007

KEITH FRANTZ

401 WEST STATE STREET

SUITE 200

ROCKFORD, IL 61101

EXAMINER

RODRIGUEZ, JOSEPH C

ART UNIT

PAPER NUMBER

3653

MAIL DATE

DELIVERY MODE

08/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/838,045

**Applicant(s)**

MISCHO, DONALD J.

**Examiner**

Joseph C. Rodriguez

**Art Unit**

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-27,29-34,45 and 48-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-27,29-34,45 and 48-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-27, 29-34, 45 and 48-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24, 45 and 48 recite the limitation "the asphalt-aggregate ratio". There is improper antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-27, 32-34 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Omann (US 5,451,003).

Regarding claims 24, 32-34, 45, Omann teaches shredding the waste shingles to a specific size (col. 4, ln. 44-61; col. 6, ln. 27-36) and then separating said materials with a screen (68, 132; col. 6, ln. 58-63), wherein the material penetrating the screen can be regarded as fines with an asphalt-aggregate composition as the shredded waste shingles contain an aggregate layer (i.e., rock) (col. 1, ln. 36-48) and the materials not

penetrating the screen can be regarded as the coarse material. Here, Applicant teaches that an asphalt-aggregate ratio can be established by setting a shredder size or a screen opening size (spec., para. 44-47), thus Omann can be interpreted as establishing and controlling an asphalt-aggregate ratio when teaching a shredder or a screen set to a specific size. Omann (col. 6, ln. 47-57) also teaches the addition of other granular material during processing-- a step that can be interpreted as controlling the asphalt-aggregate ratio in the fines as the addition of granular particles Omann impacts this ratio. That is, Omann teaches processing the waste shingles for use in roadways (Abstract; col. 6, ln. 47-57), thus the roadways material requirements can be regarded as "establishing" the "target asphalt-aggregate ratio" and the addition of granulated material can be regarded as "controlling" the asphalt-aggregate ratio in the fine material "independently" of the establishing step.

Regarding claims 25-27, 29, Omann teaches checking the ratio (i.e., gradation testing) of the material being processed and changing the screens sizes (col. 6, ln. 35-63). Further, the shredding devices (38, 138) can be regarded as separation stations, wherein the addition of material, such as aggregate, with an optional third conveyor (col. 6, ln. 48-56) or the changing of the screen aperture size can be regarded as adjusting said separation rate.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29, 32-34, 48 and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Omann (US 5,451,003) in view of Miller et al. ("Miller")(US 4,726,530).

Omann as set forth above teaches all that is claimed except for expressly teaching adjusting the first maximum size of shredded material to specific sizes towards obtaining a specific target asphalt-aggregate ratio in the fine material. Miller, however, teaches multiple types of shredders of various sizes (Fig. 1 see 10, 30, 70, 100, 110) and, moreover, teaches that the final product size depends on its end use (col. 11, ln. 49 et seq.). Based on Miller's teachings, it would be obvious to one with ordinary skill in the art to adjust the shredder sizes of Omann towards obtaining a specific target-ratio. The rationale for this obviousness determination can be found in the prior art itself as Miller teaches it is known to select a shredder size based on the desired end product, wherein market requirements for materials of specific strengths (i.e., ratios) and sizes provide further rationale for selecting specific shredders sizes. Further, the prior art discussed and cited demonstrates the level of sophistication of one with ordinary skill in the art and that the step of adjusting the shredder sizes would be well within this skill level. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Omann with different shredder sizes as it is well known that different screens or shredders sizes control the

various material ratios and sizes and that market incentives control the required material ratios and sizes.

Claims 30-31 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Omann (US 5,451,003) and Miller in view of Brock (US 5,201,472), Suzuki (JP 55142502 A) and what is well known in the art.

Omann and Miller teach all that is claimed except for expressly teaching a specific ratio by weight and by volume. The mere choice of a ratio by weight or by volume, however, is well known in the art and Examiner takes Official Notice of such. Here, it is noted that aggregate ratios are known to relate to the material strength of certain substances (Suzuki, English Abstract), thus the mere selection of the ratio can not be regarded as novel when this ratio is a mere design choice related to the common variable of desired material strength. Further, Brock teaches that it is known to set and monitor the aggregate ratio by weight for better handling (col. 5, ln. 30-col. 6, ln. 48). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Omann and Miller for reasons set forth above.

Further, it is here noted that Applicant failed to properly traverse this finding, thus this feature can be regarded as admitted prior art.

### ***Response to Arguments***

Applicant's arguments that the prior art fails to teach the claimed features are unpersuasive in view of the newly formulated prior art rejections set forth above. Applicant is advised to review the prior art rejections in light of the Supreme Court's analysis set forth in KSR.

### ***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST). The Supervisory Examiner is Patrick Mackey, **571-272-6916**. The **Official** fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>

Art Unit: 3653

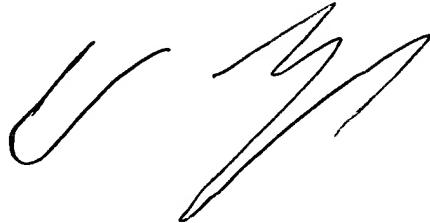
Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

Signed by Examiner /Joseph Rodriguez/

Jcr

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August 3, 2007

A handwritten signature in black ink, consisting of a stylized 'J' followed by a series of loops and a final downward stroke.